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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/886,160

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John Otto Piepenbrink

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EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/886,160	Applicant(s) PIEPENBRINK ET AL.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Information Under 37 CFR § 1.105

1. MPEP 704.10 → 37 CFR 1.105. Requirements for information.

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, Examiner is asking for:

(i) **Commercial databases** : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) **Search** : Whether a search of the prior art was made, and if so, what was searched.

(iii) **Related information** : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) **Information used to draft application** : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) **Information used in invention process** : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) **Improvements** : **Where the claimed invention is an improvement, identification of what is being improved.**

(vii) **In Use** : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) **Technical information known to applicant** . Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

1. This is a request that applicants provide the information identified above especially where emphasis added. If applicants have this information, then applicants are required, under the provisions of 37 CFR 1.56, to disclose the information to the Office. A copy of 37 CFR 1.56 is enclosed for the convenience of the applicants.

2. Applicants are not required or being asked to conduct a search for information beyond applicants own immediate files. If applicants do not have immediate knowledge of the information requested, then a statement that the information sought is unknown or not readily available to the applicants will be accepted by the office as a complete reply.

3. **Why the Request for Information is Reasonably Necessary** -

Examiner after a thorough search through several databases has been unable to find the specific concept/ alleged improvement over the prior art; that of using *for venture information* a database in the manner claimed, with a column-row matrix of records, and when queried, duplicating the single record from a first column of the queried row to a second column of the queried row. However Examiner is confident that the database used for the venture information is the same as that of Jarske.

However Applicant/Assignee IBM has been in the service Database/software development services for many years. Applicant likely may possess knowledge reasonably pertinent to the examination of this application. If so please do not overwhelm Examiner, just provide the most pertinent art.

4. **Information Requested of Applicants:** Are you aware of (1) a database with a column-row matrix of records, and when queried, duplicating the single record from a first column of the queried row to a second column of the queried row. (2) dates of the aforementioned information, and any publications and or photos associated with said database and/or (2) publications on or about database on or before 21 June 2001? If applicants' answer to this question is "Yes", applicants

are required to identify the publication(s)/ requested information and the basis upon which applicants believe that these publications had this capability on or before 21 June 2001.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flowchart of the process claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 1st

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There exist many problems with enablement that would require examiner or one attempting to practice invention do conduct undue experimentation in order to practice use of said application/invention. The below are examples of components/limitations that are not enabled by the specification that can be applied to all of the claims where found.

5. As to "providing venture information" Applicant has stated the term with no definite scope as to include anything. Venture information submitted by one user may not be included in information submitted by another user. In fact there are limitless possibilities as to "venture information" could be. And for this reason alone Examiner would have to conduct undue experimentation to figure out what information is collected/ or is desired by user collecting said information. Making the user of the software the actual inventor. Just as a person using an Excel spread sheet to conduct Applicants recording of data into rows and columns would be an inventor per se.

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6. As to "providing scoring data" there is no teaching of how to arrive at scoring data on the limitless possibilities of venture information that could be entered. For instance how would one "provide scoring data" on a business plan as found in claim 10? This would be left up to the subjective mind of the person considering joining the Venture. For examiner to figure out how to provide a scoring data to all of the venture information possibilities would require undue experimentation.

7. Also as to the analyzing a relationship and deploying one if positively evaluated. There is no framework and or teaching as to how or when to make the determination and employ the business relationship. And what a positive evaluation is and how determined and to do so would required undue experimentation.

Claim Rejections - 35 USC § 112 2nd

8. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. With respect to claim 5 for instance Applicant states "...duplicating the single record from an original column of the queried row to a duplicate column of the queried row..." When Examiner turns to Fig 9, it appears that Applicant really is "...duplicating the single record from a previous column of the queried row to a later column of the queried row..." Now due to the amended claims it is indefinite to which later column the duplicated record will fall in.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in the test of:

whether the invention produces a useful, concrete, and tangible result.

The present invention fails the “useful, concrete, tangible” result test. For an invention to be “useful” it must satisfy the utility requirement of section 101. The PTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP 2107. The claim must be for a practical application that produces a useful result and the Applicant should specifically recite in the claim the practical application. A claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of an abstract idea, but the claim is broader than the disclosure such that it recites an abstraction, then the claim must be rejected. In the present case Applicant mentions in the specification that the Venture Information is “information pertaining to a venture company (eg business plan, customers, predicated sales etc”. Obviously “venture information” as used in the claim can be read so broadly as to include statutory subject matter and non.

Furthermore even if Applicant were to chose entering in a business plan there is no teaching as to how to provide a score or a number. IF this is done by a human, it would not be subject matter for patent and too subjective and not be concrete or substantially repeatable. Hence it would fail the concreteness requirement of section 101 because it is still unpredictable in that it is left in the hands of an arbiter to subjectively decide. The present invention lacks concreteness. Usually concreteness arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*. In this regard Examiner turns to the Specification to make out how the "evaluating the opportunity to enter into a relationship is determined and finds little or no guidance as to how this is determined. No enabling disclosure is present. For example To determine this would be to invent the invention due to all of the possible outcomes that could be expected and the many hours of undue

experimentation to determine the results and even still another person skilled in the art may come to a completely decision as to what score to provide and whether or not to enter into venture, hence the invention lacks concreteness and is not enabled.

The claims are also rejected under Ex parte Bilski's analysis of 101. This is in that because the term "venture information" can be read to be so broad that it covers (preempts) any and every possible way that the steps may encompass, both known and unknown. Further it may be so broad that it covers both statutory and nonstatutory subject matter (In re Musgrave, 431 F.2d at 893)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0014373 (Perge) in further view of US 2001/0023477 A1 (Jarske). Note: due to

the numerosity of claims and the repetitiveness thereof the most comprehensive claim 9 was examined for purposes of this action and its dependents up to 13.

Claim 9 is rejected under 35 U.S.C. 103 as being unpatentable over the Perge in view of Jarske. The Chandler reference discloses all of the informational features normally provided to a venture company considering entering a relationship (Figs 2 and 3). Further Perge discloses that the questionnaire/information provided automatically populates a pre-scripted narrative form that is available to download or access electronically that may also be subject to a rating system which in turn can be used to evaluate potential investment/venture opportunities (Fig 3 "goodness-of-fit"). Chandler does not discuss the type of database used and or how the data stored in it is searched or queried in the manner claimed by Applicants.

However Jarske teaches copying first memory rows into second memory rows which is achieved with parallel memory updating, by copying a row from the first memory to a row in the second memory. The rows in the first memory are old (not updated) and the rows formed in the second memory are new (updated). [0012] Jarske also teaches that this method of updating is faster and eliminates trace back. [0008] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the row/column updating method taught by Jarske to store and access the data in one's database in a typical venture evaluation system such as that taught in Chandler for the purpose of obtaining account information. The desirability to do this is clearly to save a time and eliminate trace back while providing the most up to date information at the time of query.

Response to Arguments

14. Applicant's arguments with respect to the claims have been considered but are not persuasive and addressed below and/or now moot in view of the new ground(s) of rejection.

15. In reply to: to page 16 bridging page 17, 112 1st rejection; Applicant states that as to what information can be is found on page 9, line 10-11 it should be noted that this definition is not close ended "etc." if Applicant wants it not to read on both known and unknown Applicant should claim. Furthermore the rejections will hold related to scoring data until Applicant addresses and argues otherwise.

16. In reply to: pg 18 bottom of the page Applicant states that the claimed function involves "... a *transformation*, eg, the gathering, storing, *processing*, etc. a data used to determine whether a relationship is to be established." The limiting steps that Applicant has just argued, where emphasis added, has not been claimed, only argued. The claims don't recite any of what Applicant has just argued thus Examiner cannot reply.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
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